



Patent

Attorney Docket No: ART-00106.P.1.1-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)

Huang *et al.*)

Examiner: Ann Y. Lam

Application Number: 10/022,058)

Group Art Unit: 1641

Filed: December 13, 2001)

For: ACTIVE AND BIOCOMPATIBLE)
PLATFORMS PREPARED BY)
POLYMERIZATION OF)
SURFACE COATING FILMS)

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Madam,

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action mailed September 21, 2004, Applicants submit the following election and traverse. Applicants submit this response within three months of the mailing of the Office Action. Thus, a two month extension is requested under 37 CFR 1.136(a) and the fee of \$225.00 is enclosed herewith.

12/29/2004 RNEBRAHT 00000015 10022058

01 FC:2252

225.00 OP

I. ELECTION

Applicants elect the invention of Group I, drawn to a platform that comprises a surface, a coating film and a channel structure. This election is made with traverse.

The above-identified patent application has been examined for restriction purposes only. The Examiner has set forth the following 10 Groups:

Group Number(s)	Claims	Subject Matter
I	1-35	A platform
II	36	A method of making a platform
III	87	A method of separating moieties
IV	88	A method of performing a bioassay
V	89	A method of performing a chemical reaction
VI	90	A method of performing high performance liquid chromatography
VII	91	A method for performing capillary electrophoresis
VIII	92	A method for performing capillary electrochromatography
IX	93	A method for cell separating
X	94	A method for capturing a cell

In the Office Action, the Examiner restricts the claims to ten distinct and independent inventions. For the following reasons, Applicants traverse this restriction requirement.

A. Standard for Restriction

The M.P.E.P. (May 2004) sets forth the standard for restriction requirements:

There are two criteria for a proper requirement for restriction between patentably distinct intentions:

- A. The inventions must be independent (see M.P.E.P. §802.01, §806.04, §808.01) or distinct as claimed (see M.P.E.P. §806.05 - §806.05(i)); and
- B. There must be a serious burden to the examiner if restriction is required (see M.P.E.P. §803.02, §806.04(a) - (j), §808.01(a) and §808.02).

M.P.E.P. § 803 (May 2004)

The term “independent” (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not useable together as disclosed or (2) process and apparatus incapable of being used in practicing the process.

M.P.E.P. § 802.01 (May 2004).

B. The Claims

Claims of Group I and Group II, as set forth in the application, while being patentably distinct, do not require restriction as they are connected by a single, searchable unifying relationship that connects the claims in design. M.P.E.P. § 802.01 (May 2004). Because of the single, searchable unifying relationship, the Examiner would not be seriously burdened by searching and examining the claims together in a single application.

The claims are connected by a single searchable unifying relationship, namely a platform that comprises a biochip, where the platform has a surface, a coating film, and a channel structure that is defined in part by the coating film. This unifying relationship connects the claims of the groups in design because all claims relate to the same integrated biochip system. The single searchable unifying element can be primarily searched by electronically searching key words.

Because the claims as set forth in the application are patentably distinct, are not independent and are connected by a single searchable unifying element, the Examiner would not be seriously burdened by examining these claims together. Applicants request that the Examiner join the claims of Groups I and II. Accordingly, the USPTO would not be unduly burdened to search and examine the claims of Groups I, and II.


III. CONCLUSION

Applicants elect the invention of Group I, however, based on the commonality of the subject matter, Applicants request that the Examiner join the pending claims of Groups I and II into a single group. Applicants respectfully submit that the claims are ready for examination and in condition for allowance.

Please apply any charges not covered, or any credits, to **Deposit Account Number 501321** in the name of David R. Preston & Associates, having **Customer Number 24232**.

Respectfully submitted,

Date: Dec 21, 2004

A handwritten signature in black ink, appearing to read 'David R. Preston', with a stylized flourish at the end.

David R. Preston
Reg. No. 38,710

David R. Preston & Associates, APC
12625 High Bluff Drive
Suite 205
San Diego, CA 92130

Telephone: 858.724.0375
Facsimile: 858.724.0384